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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,497	09/28/2006	Atsuo Otsuji	1034232-000050	3731
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EXAMINER				
SOLOLA, TAOFTQ A				
ART UNIT		PAPER NUMBER		
1625				
NOTIFICATION DATE		DELIVERY MODE		
09/29/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/594,497

Applicant(s)

OTSUJI ET AL.

Examiner

Taofiq A. Solola

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 3-6 is/are rejected.
- 7) ☐ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 9/28/06/5/14/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Claims 3-8 are pending in this application.

Claims 1-2, 9-14 are deleted.

Restriction Requirement

The election of group I, claims 3-6, with traverse in the Paper filed 7/13/09 is hereby acknowledged. The traversal is on the basis that formula 3 includes not only thietane but also other moieties as well as a metal. This is not persuasive because thietane is the only structure shared by all the groups. Formula 3 changes when any of the variables changes including the metal. Therefore, formula 3 represents several structures not shared by all the compounds (species) of the inventions. Also, the prior art by Dittmer et al., teaches Si as a metal. See the heading, line 3. However, the restriction of claims 7-8 is hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Dittmer et al., Org. Magnetic Resonance, (1982), Vol. 18(2). Pp. 82-86.

Dittmer et al., disclose compounds of formula (I) and compositions thereof. See page 82.

The formula has few substituents (X and Y) each of which are very limited (see the definitions of X (3-substituents) in the heading). There are no alternative points of attachments of the substituents to the central structure, and the central structure does not change. Therefore, Dittmer et al., have described to those of ordinary skill in [the] art each of the various permutations involved . . . as fully as if [they] had drawn each structural formula or had written each name." *In re Petering*, 133 USPQ 275 (CCPA 1962).

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Claim 6 cites intended use. Under the US patent practice intended use is not a limitation in a compound or composition claim. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dittmer et al., Org. Magnetic Resonance, (1982), Vol. 18(2). Pp. 82-86.

Applicant claims compounds of formula 3 and composition thereof. In the formula, X1 is O; p is 1; m is 0; M is Sn, Si, Ge or Pb; Yq is alkyl and n-p is 3.

Determination of the scope and content of the prior art (MPEP 2141.01)

Dittmer et al., disclose fluorescein compounds of formula (I) and compositions thereof. See page 82 for formula 1, and the heading. In the formula, X1 is O; p is 1; m is 0; M is Si; Yq is methyl (alkyl) and n-p is 3.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of the prior art is that Applicant claims Sn, Ge and Pb instead of Si as M.

Finding of prima facie obviousness—rational and motivation (MPEP 2142.2413)

However, Sn, Si, Ge and Pb are metals of the same group IVA. Therefore, the instant invention is prima facie obvious from the teaching of the prior art. One of ordinary skill in the art would have known to replace Si with Sn, Ge or Pb at the time the invention was made. The motivation is from knowing that metals of the same group have similar activities.

Objection

Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit 1625

September 22, 2009